

REMARKS

These amendment and remarks are being filed in response to the Office Action mailed September 14, 2007 (the "Office Action"). At the time of the Office Action, claims 1-5 were pending and claim 5 was withdrawn. The Office Action rejected all of the claims under 35 U.S.C. §102(b) and/or 35 U.S.C. §112, second paragraph. The rejections and response thereto are set forth fully below.

By this Amendment, claim 1 is amended, claim 2 is cancelled, and claim 6 is added. No new matter is added. As the total number of claims does not exceed twenty (20), no additional claim fees are believed to be due.

Claim Rejections – 35 U.S.C. § 112, second paragraph

In the Office Action, claim 2 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This rejection is moot as claim 2 has been cancelled by this Amendment.

Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1-4 were rejected under 35 U.S.C. § 102(b) as being unpatentable over the translation of PCT Patent Application Publication WO99/20230 filed by Hurschmann *et al.* (hereinafter "Hurschmann"). In particular, the Office Action references the composition of Formulation R2. This rejection is addressed in detail below.

Prior to reviewing the cited reference, Applicants wish to review the pending claims. Claim 1 is drawn to:

1. (currently amended) A moisture-proof mascara composition, characterized by a stable colloidal complex comprising
 - 0.1 to 10 % by weight of a water-soluble polymer selected from among polyvinylpyrrolidone, vinyl acetate/vinyl pyrrolidone copolymers and mixtures thereof,
 - 0.5 to 10 % by weight of stearic acid and
 - 1 to 40 % by weight of a wax or wax mixture,and manufactured by adding the water-soluble polymer or copolymer into the oil phase consisting of the melted wax or wax mixture, and optionally an emulsifier,

until a stable colloidal complex is formed, and emulsifying the said complex in homogeneous form with an aqueous phase.

It is important to note that the claims are drawn to an oil phase that consists of the melted wax or wax mixture, stearic acid and optionally an emulsifier. The water-soluble polymer or copolymer is mixed into the oil phase until a stable colloidal complex is formed. Only after the stable colloidal complex is formed is the complex emulsified with an aqueous phase.

The process of mixing the water-soluble polymer or copolymer into the oil phase, formulated with specific components in specific amounts, results in an end product that provides significantly improved moisture-resistance when compared to conventional mascara. As noted in the specification, polyvinyl pyrrolidone is hygroscopic and generally results in smearing of mascara, *see* Specification, paragraph [0003]. However, Applicants have discovered that mixing the wax phase with the PVP containing water-soluble polymer before introducing an aqueous phase produces a mascara with substantially improved moisture resistance, *see* Specification, paragraphs [0028]-[0031]. This demonstrates that the subject matter of claim 1 is physically distinct from compositions made by the methods disclosed in Hurschmann, *see* Specification, paragraph [0033].

Applicants now turn to the Hurschmann reference. The Office Action asserts that Hurschmann discloses a hair mascara composition comprising 8 % stearic acid, 0.5 % Luviskol VA 64 (vinylacetyl-vinylpyrrolidone copolymer), and 0.5-1.0 % carnuba wax. The Office Action goes on to assert that PVP is taught on page 4, and that active agents (*e.g.* pigments, perfumes) and emulsifiers (*e.g.* cetylstearyl alcohol) are also included in the composition. In particular, the Examiner points to Formulation R2 from Hurschmann.

Applicants respectfully submit that neither Hurschmann nor R2 disclose creating an oil phase and mixing it with a PVP comprising water-soluble polymer before introducing an aqueous solution. Similarly, neither Hurschmann nor R2 discloses that the oil phase should consist of "melted wax or wax mixture, stearic acid and optionally an emulsifier" as set forth in claim 1.

The subject matter of the claims utilizes a water-soluble polymer selected from PVP, VA/VP copolymer and mixtures thereof, and added to the oil phase, which consists of melted wax, stearic acid and optionally surfactant. This composition is mixed until a stable colloidal complex is formed. Only a very small quantity of PVP emerges from the colloidal complex, even upon subsequent contact with the aqueous phase.

Instead, Hurschmann describes working all of the components into a suitable water-containing carrier, *see* Hurschmann, paragraph bridging pages 5-6. Thus Hurschmann teaches away from the claims which require (i) formation of an oil phase, (ii) formation of a stable colloidal complex by thoroughly mixing the water-soluble polymer with the oil phase, and (iii) emulsifying the colloidal complex in homogeneous form with an aqueous phase. Clearly, Hurschmann provides no disclosure or suggestion of the specific manufacturing process that results in a different end product with improved moisture-resistance.

Contrary to the assertion in the Office Action that using the same material results in the same product, there is evidence that the end product of the claims is significantly different from that disclosed or suggested by Hurschmann. First, the specification demonstrates that the product of the claims exhibits twice the moisture-resistance of commercial PVP mascaras, *see* Specification, paragraph [0028]-[0031]. Second, the specification describes that creating the colloidal complex, *i.e.* mixing PVP with the oil phase rather than directly with the aqueous phase, produces significant changes in the PVP crystals that are recovered once the water evaporates, *see* Specification, paragraph [0010]. Applicants believe that this difference a direct result of the process of the claims and that the difference helps explain the improved moisture-resistance.

The results of the study of PVP crystals resulting from a 4% mixture of PVP in wax and a separate mixture of 4% PVP in water provides some insight into these differences. First, after evaporation of water, the PVP crystals were 5 wt-% of the PVP/wax mixture, while the PVP crystals were only 4 wt-% of the PVP/water mixture. This demonstrates that the wax has some impact on the PVP crystal structure, *see* Sepcification, paragraph [0010]. As discussed in the specification, the resulting crystals are also different. The PVP/wax crystals are "large shiny,

slightly yellow, harder crystals," while the PVP/water crystals were "very small." Pictures of representative crystals are shown as Sample A (PVP/wax) and Sample B (PVP/water) below.



In order to form the mascara described in Hurschmann, all of the mascara ingredients are simultaneously or sequentially "worked into a suitable *water-containing* carrier." The mascara composition set forth in the claims, requires (i) formation of an oil phase, (ii) formation of a stable colloidal complex by thoroughly mixing the water-soluble polymer with the oil phase, and (iii) finally, emulsifying the colloidal complex in homogeneous form with an aqueous phase. As described in the application, this results in a mascara complex with twice the moisture-resistance found in conventional PVP-containing mascara, such as that which could be produced using Hurschmann. The specification outlines physical differences in the PVP crystals that result from the claimed PVP/wax mixtures versus the PVP/water mixtures disclosed in Hurschmann. These differences help demonstrate that the product produced by the process set forth in the claims is different from that which is disclosed or suggested by Hurschmann. Accordingly, Applicants respectfully submit that they have demonstrated a difference in the product, which is entitled to patentable weight.

Claim Amendments

Amended claim 1 adds the limitation that an emulsifier may be present in the oil phase. Support for this amendment can be found throughout the specification, including Example 1 and claim 4.

New claim 6 is drawn to the mascara composition of claim 1 "comprising 10 to 28 % by weight of a wax or wax mixture." Support for this claims can be found throughout the specification, including paragraph [0012]. No new matter is added.

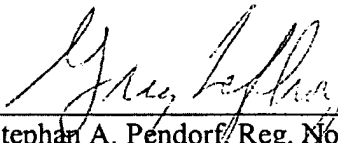
Applicants note that this amount of wax is neither disclosed nor suggested by Hurschmann, which discloses 0.1-3 wt-% wax and preferably 0.5-1.0 wt-% wax (*see* Hurschmann, page 4, 1st full paragraph). In fact, Hurschmann's ranges clearly teach away from the subject matter of claim 6.

Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding, Applicant invites the Examiner to call the undersigned Greg Lefkowitz at 561-671-3624 (direct line) if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

Date: December 14, 2007


Stephan A. Pendorf, Reg. No. 32,665
Gregory M. Lefkowitz, Reg. No. 56,216
AKERMAN SENTERFITT
222 Lakeview Avenue; Suite 400
P.O. Box 3188
West Palm Beach, FL 33402-3188
(561) 653-5000

Docket No. 3975-038